REMARKS

I. Introductory Comments

In the Office Action under reply, the Examiner indicated that the claims were rejected as follows: under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-53 of U.S. Patent No. 6,362,254 (claims 54-79); under 35 U.S.C. §102(e) as allegedly being anticipated by Harris et al. (U.S. Patent No. 6,362,254) (claims 54-79); under 35 U.S.C. §101 as allegedly claiming the same invention as that of claims 1-53 of U.S. Patent No. 6,541,543; and under 35 U.S.C. §102(e) as allegedly being anticipated by Harris et al. (U.S. Patent No. 6,541,543) (claims 54-79). The rejections are traversed for reasons provided below.

II. The Interview of March 3, 2005

At the undersigned's request, an interview with the Examiner was conducted on March 3, 2005. During the interview, the propriety of one or more claims rejections was discussed (although no resolution was reached).

III. The Obviousness-type Double Patenting Rejection

The Examiner has rejected claims 54-79 under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-53 of U.S. Patent No. 6,362,254. To obviate this rejection, an executed terminal disclaimer is enclosed herewith. In view thereof, it is submitted that the nonstatutory double patenting rejection of the present claims is overcome. Applicants note that submission of the terminal disclaimer is for expediency purposes only and is not intended as an acquiescence in the rejection.

IV. The First 35 U.S.C. §102(e) Rejection

The Examiner rejected claims 54-79 under 35 U.S.C. §102(e) as allegedly being anticipated by Harris et al. (U.S. Patent No. 6,362,254). Applicants traverse the rejection on the ground that Harris et al. (U.S. Patent No. 6,362,254) does not represent prior art to the present application under 35 U.S.C §102(e).

As set forth in 35 U.S.C §102(e), a person shall be entitled to a patent unless

> the invention was described in a patent granted on an application for patent **by another** filed in the United States before the invention thereof by the applicant for patent.

[Emphasis added]. Here, because the inventive entities for both the present application and Harris et al. (U.S. Patent No. 6,362,254) list J. Milton Harris and Antoni Kozloski, Harris et al. (U.S. Patent No. 6,362,254) is not a patent granted on an application **by another**. As a consequence, Harris et al. (U.S. Patent No. 6,362,254) does not qualify as prior art to the present application under 35 U.S.C. §102(e). Reconsideration and removal of the rejection is respectfully requested.

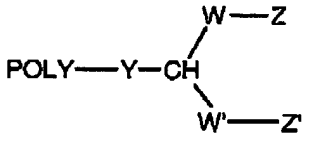
V. The Rejection Under 35 U.S.C. §101, "Statutory Double Patenting"

The Examiner rejected claims 54-79 as allegedly claiming the same invention as that of claims 1-53 of prior U.S. Patent No. 6,541,543.

As pointed out in Section 804 of the Manual of Patent Examination and Procedure ("M.P.E.P."),

> In determining whether a statutory basis for a double patenting rejection exists, the question to be asked is: Is the same invention being claimed twice? ... "Same invention" means identical subject matter. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1984); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957).
>
> ... Is there an embodiment of the invention that falls within the scope of one claim, but not the other? If there is such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting would not exist.

Here, pending claim 1 recites a polymer comprising the following structure:



wherein:

POLY is a water-soluble, substantially non-immunogenic polymer;

Y is a hydrolytically stable linkage;

W is a first tethering group;

W' is a second tethering group;

Z is a first reactive moiety; and

Z' is a second reactive moiety.

As is evident in the above claim, the "branching atom" for polymers encompassed by the claim is a carbon atom. In addition, both -W-Z and -W'-Z' groups (as defined in the claim) are required.

In contrast, claim 1 of U.S. Patent No. 6,541,543 (the only independent claim of the patent) recites a structure wherein "A is a branching atom." The specification at column 7, lines 17-19, recites that the "branching atom ... is not a nitrogen atom (N), but is typically a carbon atom (C)," thereby allowing for branching atoms other than carbon (and nitrogen). Furthermore, no dependent claim specifically requires both "C" as a branching carbon *and* -W-Z and -W'-Z' groups.

Thus, for at least the reason provided above, there are embodiments of polymers that fall within the scope of U.S. Patent No. 6,541,543 and not present claims. Consequently, reconsideration and removal of the statutory double patenting rejection is respectfully requested.

VI. The Second 35 U.S.C. §102(e) Rejection

The Examiner rejected claims 54-79 under 35 U.S.C. §102(e) as allegedly being anticipated by Harris et al. (U.S. Patent No. 6,541,543). Applicants traverse the rejection on the ground that Harris et al. (U.S. Patent No. 6,541,543) does not represent prior art to the present application under 35 U.S.C §102(e).

> As set forth in 35 U.S.C §102(e), a person shall be entitled to a patent unless
>
> the invention was described in a patent granted on an application for patent **by another** filed in the United States before the invention thereof by the applicant for patent.

[Emphasis added]. Here, because the inventive entities for both the present application and Harris et al. (U.S. Patent No. 6,541,543) list J. Milton Harris and Antoni Kozloski, Harris et al. (U.S. Patent No. 6,541,543) is not a patent granted on an application **by another**. As a consequence, Harris et al. (U.S. Patent No. 6,541,543) does not qualify as prior art to the present

application under 35 U.S.C. §102(e). Reconsideration and removal of the rejection is respectfully requested.

VII. The Information Disclosure Statement

Applicants transmitted an Information Disclosure Statement [along with the fee required under 37 C.F.R. §1.17(p)] on October 12, 2004. Applicants would greatly appreciate an initialed copy of the forms indicating that the Examiner considered each of the listed references.

VIII. Conclusion

In view of the foregoing, Applicants submit that the pending claims satisfy the requirements of patentability and are therefore in condition for allowance. Reconsideration and withdrawal of all objections and rejections is respectfully requested and a prompt mailing of a Notice of Allowance is earnestly solicited.

If a telephone conference would expedite the prosecution of the subject application, the Examiner is requested to call the undersigned at (650) 620-5506.

Respectfully submitted,
Nektar Therapeutics

Date: March 8, 2005 By: Mark A. Wilson

Mark A. Wilson
Registration No. 43,275

Nektar Therapeutics
150 Industrial Road
San Carlos, CA 94070
(650) 631-3100 (Telephone)
(650) 631-3125 (Facsimile)

This Page is Inserted by IFW Indexing and Scanning Operations and is not part of the Official Record

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☐ BLACK BORDERS
- ☐ IMAGE CUT OFF AT TOP, BOTTOM OR SIDES
- ☐ FADED TEXT OR DRAWING
- ☐ BLURRED OR ILLEGIBLE TEXT OR DRAWING
- ☐ SKEWED/SLANTED IMAGES
- ☐ COLOR OR BLACK AND WHITE PHOTOGRAPHS
- ☐ GRAY SCALE DOCUMENTS
- ☒ LINES OR MARKS ON ORIGINAL DOCUMENT
- ☐ REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY
- ☐ OTHER: _____

IMAGES ARE BEST AVAILABLE COPY.
As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.